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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,211	11/16/2001	Peter M. Bonutti	BON-2950-2	7013

33771 7590 09/11/2003

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EXAMINER

THALER, MICHAEL H

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 09/11/2003

25

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/992,211

Applicant(s)

BONUTTI ET AL.

Examiner

Michael Thaler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57-62,64-73,75 and 77-79 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 57-62,64,65,72,73,75 and 77-79 is/are allowed.
- 6) ☒ Claim(s) 66,70 and 71 is/are rejected.
- 7) ☒ Claim(s) 67-69 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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Claims 66 and 70 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kratoska et al. Kratoska et al., in figures 7A-7C, show tubular sheath 200 and an array of filaments 207 (as described in col. 24, lines 57-61) which extend along an inner side of the passage of sheath 200. The Kratoska et al. sheath 200, passage and array of filaments 207 are resiliently expandable from a contracted condition to an expanded condition, wherein said sheath is biased inwardly to the contracted condition (col. 24, lines 23-43 and col. 24, line 62 to col. 25, line 7). The array of filaments 207 inhibits contact between an object inserted in the passage and the sheath (col. 24, lines 57-61). Filaments 207 are "filaments" since they are thin and elongated. Alternatively, it would have been obvious that ribs 207 are "filaments" since they are thin and elongated. As to claim 70, the Kratoska et al. sheath is inherently engageable by a member having an oval cross-section and is inherently expandable by inserting this member therein. The member having an oval cross-section is not part of the claimed combination.

Claims 66, 70 and 71 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wilk (5,312,417). Wilk shows an expandable cannula

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comprising tubular sheath 18 having a passage which extends between opposite end portions of the sheath and an array of filaments 20 (~~col. 5, lines 7-15~~), the sheath, passage and array of filaments being resiliently expandable from a contracted condition to an expanded condition, wherein the sheath is biased inwardly to the contracted position (since it is made of elastic material as indicated in col. 3, lines 40-48). The array of filaments 20 inherently inhibits contact between an object inserted in the passage and the sheath since the filaments are disposed along an inner side of sheath 18 as indicated in col. 3, lines 55-56. Alternatively, it would have been obvious that the array of filaments 20 inhibits contact between an object inserted in the passage and the sheath since the filaments are disposed along an inner side of sheath 18 and thus are located between the object and the sheath. As to claim 70, the Wilk sheath is inherently engageable by a member having an oval cross-section and is inherently expandable by inserting this member therein. The member having an oval cross-section is not part of the claimed combination. As to claim 71, Wilk shows pump means (the source of the insufflation pressure which is attached to port 14) which inherently expands the sheath to some extent due to the high pressure. Alternatively, Wilk shows pump means (the source of the

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hydraulic or pneumatic pressure in the embodiment described from col. 4, lines 64 to col. 5, line 4).

Claims 57-62, 64, 65, 72, 73, 75 and 77-79 are allowed.

Claims 67-69 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's arguments with respect to claims 66, 70 and 71 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

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advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703)308-2496. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3590 for regular communications and (703)305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

mht
September 10, 2003



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731